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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,143	04/21/2000	Ronald A. Schachar	PRES06-00163	6710

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

MTF

## Office Action Summary

Application No.

09/556143

Applicant(s)

Schachar

Examiner

L-shay

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☒ Responsive to communication(s) filed on December 30, 2002
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 31-48 is/are pending in the application.
- Of the above claim(s) 45-48 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 31-44 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

The amendment filed December 26, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the description of figures 10, 11; the disclosure running from line 21 on page 22 through the end of page 25 of the substitute specification; and newly submitted figures 10 and 11.

Applicant is required to cancel the new matter in the reply to this Office Action. Newly submitted claims 45 and 46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the apparatus could be used for a substantially different method, such as transmyocardial revascularization.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 45-48 have withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142 (b) and MPEP 821.03.

The text of those sections of Title 35, U.S. Code not included in this action can be found in prior Office action.

Claims 31-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Frankhauser et al.

Applicant asserts that the instant application incorporates U.S. Patent 5,354,331 by reference and thus the material added by the amendment of December 26, 2002 is not new matter. The examiner must respectfully disagree. The 5,354,331 patents clearly contain no figures that bear any resemblance whatsoever to applicants newly submitted Figures 10 and 11.

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Thus these figures along with the brief and detailed descriptions of these figures e.g. starting at page 38 of the markel up copy find no support in the 5,354,331 patents and are thus new matter.

Applicant's arguments filed December 30,2002 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

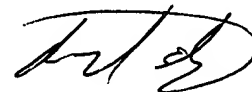
This is a Request for Continued Examination of applicant's earlier Application No. 09/556,143. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Say at telephone number 703-308-2215.

Shay/DI

March 20,2003



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330